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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,666	04/06/2001	Timothy J. Neuberger	365279-001	6738

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EXAMINER

KWON, BRIAN YONG S

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 08/12/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/827,666

Applicant(s)

NEUBERGER ET AL.

Examiner

Brian S Kwon

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-66 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-36 and 43-66, drawn to a method of use with a composition comprising a compound represented by formula (I) or (II).
 - II. Claims 37-38, drawn to a composition comprising a compound represented by formula (I) or (II).
 - III. Claims 39-40, drawn to a composition comprising one or more cells.

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in controlling the growth of higher plants, controlling inflammation or inhibiting tumor progression or modulating immune response system. In addition, Invention III differs from Invention I and II because Invention III acquires a separate status in the art.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

2. Furthermore, if applicant elects Group I invention, it is subject to further restriction as followings.

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- I-a. Claims 1-18, 32-36 and 57-58, drawn to a method for promoting tissue regeneration with a composition containing compound represented by formula (I), classified in class 514, subclass 443.
- I-b. Claims 19-28 and 46-56, drawn to a method for promoting increased neuronal function after a decrease in neuronal function due to a trauma, an injury or a neurodegenerative disease or condition with a composition containing compound represented by formula (I), classified in class 514, subclass 443.
- I-c. Claims 29-31, drawn to a method for improving learning or memory function with a composition containing compound represented by formula (I), classified in class 514, subclass 443.
- I-d. Claims 43-45, drawn to a method for promoting the proliferation or differentiation of progenitor cells with a composition containing compound represented by formula (I) 514, classified in class, subclass 443.
- I-e. Claims 59-63, drawn to a method for treating a liver disease or condition with a composition containing compound represented by formula (I), classified in class 514, subclass 443.
- I-f. Claims 64-66, drawn to a method for growing cells in vitro or in vivo with a composition containing compound represented by formula (I), classified in class 514, subclass 443.
- I-g. Claims 1-18, 32-36 and 57-58, drawn to a method for promoting tissue regeneration with a composition containing compound represented by formula (II), classified in class 514, subclass 605, 381.

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- I-h. Claims 19-28 and 46-56, drawn to a method for promoting increased neuronal function after a decrease in neuronal function due to a trauma, an injury or a neurodegenerative disease or condition with a composition containing compound represented by formula (II), classified in class 514, subclass 605, 381.
- I-i. Claims 29-31, drawn to a method for improving learning or memory function with a composition containing compound represented by formula (II), classified in class 514, subclass 605, 381.
- I-j. Claims 43-45, drawn to a method for promoting the proliferation or differentiation of progenitor cells with a composition containing compound represented by formula (II), classified in class 514, subclass 605, 381.
- I-k. Claims 59-63, drawn to a method for treating a liver disease or condition with a composition containing compound represented by formula (II), classified in class 514, subclass 605, 381.
- I-l. Claims 64-66, drawn to a method for growing cells in vitro or in vivo with a composition containing compound represented by formula (II), classified in class 514, subclass 605, 381.

Inventions I-a-I-l are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01).

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and their different classification, restriction for examination purposes as indicated is proper.

3. If applicant elects Group II invention, it is subjected to further restriction as following.

II-a. Claims 37-38, drawn to a composition comprising a compound represented by the formula (I), classified in class 514, subclass 605, 433.

IIb Claims 37-28, drawn to a composition comprising a compound represented by formula (II), classified in class 514, subclass 605, 381.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Kwon whose telephone number is (703)308-5377. The examiner can normally be reached Tuesday through Friday from 9:00 am to 7:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached on (703) 308-4725. The fax number for this Group is (703) 308-4556.

Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

Brian Kwon

**ZOHREH FAY
PRIMARY EXAMINER
GROUP 1600**

A handwritten signature in black ink, appearing to read 'Zohreh Fay', is written below the printed name and title.